

REMARKS

The above amendments and these remarks are responsive to the Office Action issued on July 6, 2004. By this response, claim 1 and the specification are amended to correct clerical errors, but scope of claim 1 is not narrowed for any reason related to patentability. Seven (7) sheets of formal drawings are also submitted herewith. No new matter is added. Claims 1-56 are now active for examination.

The Office Action dated July 6, 2004 rejected claims 1-21 under 35 U.S.C. §101 for being directed to non-statutory subject matter. Claims 1-6, 15, 16, 20-27, 37-45 and 53-56 were rejected under 35 U.S.C. §102(b) as being anticipated by “How CTI is Changing Workforce Management: What are the Possibilities for your Call Center?” (hereinafter “Scott”). Claims 7-11, 19, 28-33 and 46-49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Scott in view of “Automating for Better Workforce Management” (hereinafter “Reynolds”). Claims 12, 13, 14, 17, 18, 34, 35, 35 and 50-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over Scott in combination with Reynolds, and further in view of “A Microcomputer-based Data Management and Capacity-planning System” (hereinafter “Randhawa”). The Examiner objected to the drawings and specification for formality reasons.

It is respectfully submitted that the claim rejections are traversed and the objections are addressed in view of the amendments and remarks presented herein.

The Rejection under 35 USC § 101

Claims 1-21 were rejected as being directed to non-statutory subject matter. Applicants respectfully disagree.

In order to determine whether the processes described in claims 1-21 are directed to statutory subject matter, the Examiner applied a two-prong test:

- (1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

The Examiner acknowledged that the process of claims 1-21 produces “a useful, concrete and tangible result,” but nevertheless rejected claims 1-21 as being directed to non-statutory subject matter because the steps described in claims 1-21 “can be performed in the mind of the user or by use of a pencil and paper,” and thus allegedly constitute only abstract ideas for capacity planning, not the prerequisite “technical arts” that entitle to patent protections. See enumerated item 5 of the Office Action. The rejection is respectfully traversed.

Court decisions clearly indicate that “[t]he inclusion in a patent of a process that may be performed by a person, but that also is capable of being performed by a machine, is not fatal to patentability.”¹ Since the steps described in claims 1-21 can be performed by a computer (a machine), the mere possibility that the claimed steps can be performed by a human being does not by itself preclude patentability of claims 1-21 under 35 U.S.C. § 101. Accordingly, the Examiner cannot preclude patentability of claims 1-21 simply because all or part of the steps described in claims 1-21 can be performed by human beings.

Furthermore, courts have held that “abstract ideas” constitute disembodied concepts or truths which are not “useful” from a practical standpoint standing alone, i.e., they are not “useful until reduced to *some practical application*.”² Thus, a claimed process including abstract ideas or mathematical formula becomes a “useful” technical arts as long as the claimed process can produce some practical application” and will fall in the statutory subject matter under 35 U.S.C. § 101.

As already recognized by the Examiner, the processes of claims 1-21 produce a useful, concrete and tangible result by generating a capacity report for capacity planning. Therefore,

¹ See *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1 USPQ2d 1337 (Fed. Cir. 1986). See also *In re Musgrave* (431 F. 2d 882 (CCPA 1970)), in which the court states: “We cannot agree with the board that these claims...are directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of the human mind.”

even if abstract ideas are purportedly used by the processes of claims 1-21, the claimed processes produce practical application by using the purported abstract idea. Accordingly, the claimed processes of claims 1-21 are useful technical arts and entitle to patent protections. The rejection of claims 1-21 under 35 U.S.C. §101 is untenable and should be withdrawn. Favorable reconsideration of claims 1-21 is respectfully requested.

The Anticipation Rejection Is Traversed

Independent claims 1, 22 and 41 were rejected as being anticipated by Scott. The Office Action alleged that Scott teaches or discloses every feature of the claims. It is respectfully submitted that although claims 1, 22 and 41 and Scott share the same goal to determine staff capacity and calculate work volume, Scott does not teach or suggest the approaches described in the claims.

Claim 1 is directed to a capacity planning method that identifies subtasks associated with each of a plurality of tasks, and calculates a total work volume based on the amount of the identified subtasks and the amount of time or the number of staff needed to perform each of the identified subtasks. A capacity report including information related to the work volume and staff availability is then generated.

On the other hand, Scott discusses a work force management system for managing tasks and telephone sales representatives (TSR) of a calling center or telemarketing center. Principles of system designs are discussed, including forecasting staff demands for each time interval, scheduling agents, making adjustments, etc. (See paragraphs 19-22 of Scott.) Scott pointed out that it is necessary to determine unavailability of TSRs when they perform tasks other than answering calls, such as training, meeting, research, etc., and suggested that the unavailable time should be considered during scheduling TSRs (see paragraph 20 of Scott).

² *In re Alappat*, 33 F.3d 1526, 31 USPQ 2d 1454 (Fed. Cir. 1994).

In rejecting claim 1, the Office Action asserted that since Scott identifies various types of tasks (i.e., training, meeting, research), Scott teaches “identifying subtasks associated with each of the plurality of tasks,” as described in claim 1. Applicants respectfully disagree. According to Scott, the tasks that the Examiner alleged to be comparable to the subtasks are not part of the main tasks, i.e., answering calls. Rather, the tasks identified in Scott are those that TSRs need to perform other than answering calls (the main task) and thus cannot be used to answer calls. Thus, the tasks identified in Scott are not “**subtasks**” of the main task, and not associated with the main task. Accordingly, Scott does not identify subtasks associated with each of the plurality of tasks, as described in claim 1. As Scott does not identify subtasks associated with each of the plurality of tasks, Scott also fails to teach or disclose “accessing production rate information related to the amount of time or the number of staff needed to perform each of the identified subtasks,” and “calculating a work volume based on the identified subtasks and the production rate information,” as recited in claim 1. Since Scott fails to teach or disclose every limitation of claim 1, Scott cannot support a prima facie case of anticipation. The anticipation rejection is untenable and should be withdrawn. Favorable reconsideration of claim 1 is respectfully requested.

Claims 22 and 41 are system and software claims including descriptions comparable to those of claim 1. As discussed above, Scott also fails to teach or suggest every limitation of claims 22 and 41. Accordingly, the anticipation rejection of claims 22 and 41 is untenable and should be withdrawn for at least the same reasons as for claim 1. Favorable reconsideration of claims 22 and 41 is respectfully requested.

Claims 2-6, 15, 16, 20, 21, 23-27, 37-40, 42-45 and 53-56 depend on claims 1, 22 and 41, respectively, and also are rejected as being anticipated by Scott. Since claims 2-6, 15, 16, 20, 21, 23-27, 37-40, 42-45 and 53-56, by virtue of their respective dependencies on claims 1, 22 and 41, include every feature thereof, the anticipation rejection of claims 2-6, 15, 16, 20, 21, 23-27, 37-40,

42-45 and 53-56 also is untenable and should be withdrawn based on at least the same reasons as for claims 1, 22 and 41. Favorable reconsideration of claims 2-6, 15, 16, 20, 21, 23-27, 37-40, 42-45 and 53-56 is respectfully requested.

The Obviousness Rejections Are Traversed

Claims 2-21, 23-40 and 42-56, directly or indirectly, depend on claims 1, 22 and 41, respectively, and include every feature described therein. The Office Action rejected claims 2-21, 23-40 and 42-56 as being unpatentable over Scott in combination with various documents. As discussed above, Scott fails to teach identifying subtasks associated with each of the plurality of tasks, as described in claims 1, 22 and 41. Scott also fails to teach or disclose “accessing production rate information related to the amount of time or the number of staff needed to perform each of the identified subtasks,” and “calculating a work volume based on the identified subtasks and the production rate information,” as recited in claims 1, 22 and 41. The additional documents cited by the Examiner do not alleviate these deficiencies of Scott. Therefore, Scott, even combined with the additional documents cited by the Examiner, fails to teach or suggest every limitation of claims 2-21, 23-40 and 42-56. Accordingly, Scott and the cited documents cannot support a prima case of obviousness. The obviousness rejection is untenable and should be withdrawn. Favorable reconsideration of claims 2-21, 23-40 and 42-56 is respectfully requested.

The Objections Are Addressed

The Office Action objected to Fig. 3 for failing to include the reference symbol “Step 305” as described in page 20, paragraph [0052] of the written specification. The Office Action also objected to the written description for failing to include the reference symbol 315. By this Response, “Step 305” in paragraph [0052] is amended to “Step 315,” to be consistent to the reference symbol used in Fig. 3 and to the written description.

The Office Action further objected to paragraph [0056] of the specification for incorrectly reciting "September 2003 is 2150 hours," which the Examiner suggested should be "September 2003 is 2100 hours." By this Response, paragraph [0056] is amended as suggested by the Examiner. It is respectfully submitted that the objections to the drawings and the specification are properly addressed.

For the reasons given above, Applicants believe that this application is conditioned for allowance and Applicants request that the Examiner give the application favorable consideration and permit it to issue as a patent. However, if the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representatives listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, reading "Wei-Chen Chen" with a stylized flourish at the end.

Wei-Chen Nicholas Chen
Recognized under 37 CFR §10.9(b)

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FORMAL DRAWINGS:

At the time the application was filed, informal drawings were presented with the application. Seven (7) sheets of formal drawings are now submitted herewith